

Notice of Allowability

Application No.

09/332,815

Examiner

Cheryl Juska

Applicant(s)

ZEBALA, JOHN A.

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Amendment filed 08/10/04 and Interview of 09/08/04.
2. ☒ The allowed claim(s) is/are 1-36,38-81,84-87 and 89-159.
3. ☒ The drawings filed on 14 June 1999 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

Cheryl Juska
Primary Examiner
Art Unit: 1771

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Peter Knudson on September 8, 2004.

The application has been amended as follows:

In the last line of claim 42, after 'more,' please insert –different—.

In the last line of claim 92, please delete “each porous coating has at least one compound attached thereto” and insert therein –a different compound is attached to each of the porous coatings—.

Claim 129 (currently amended) A method of identifying at least one compound that specifically binds a receptor, the method comprising the sequential steps of:

- (a) providing a coated article according to claim 1 or claim 72;
- (b) contacting said coated article with a receptor; and
- (c) determining whether one or more of the compounds attached to the porous coating specifically bind to the receptor.

Art Unit: 1771

Claim 135 (currently amended). A method for identifying at least one compound that specifically binds a receptor, the method comprising the steps of:

- (a) providing a coated article according to claim 1 or claim 72;
- (b) simultaneously or in either order:
 - (i) detaching one or more compounds from said coated article; and
 - (ii) contacting the detached compound(s) with a receptor; and
- (c) determining whether the compound(s) specifically bind to the receptor.

Claim 148. (currently amended) A method for isolating a target receptor, comprising the steps of:

- (a) providing a coated article according to claim 1 or claim 72;
- (b) contacting said coated article with a composition comprising a target receptor, wherein at least one attached compound binds to the target receptor;
- (c) removing unbound components of the composition from the array; and
- (d) separating the target receptor from the coated article, and therefrom isolating the target receptor.

Claim 150. (currently amended) A method for modifying a receptor, comprising the steps of:

- (a) providing a coated article according to claim 149; and
- (b) contacting said coated article with a composition comprising a target receptor.

Claim 151. (currently amended) A method for hybridizing an antisense molecule to a target nucleic acid molecule, comprising the steps of:

- (a) providing a coated article according to claim 1 or claim 72;
- (b) contacting said coated article with a composition comprising a target nucleic acid molecule, wherein the attached compounds are antisense molecules; and
- (c) detaching one or more compounds from the array, and thereby hybridizing an antisense molecule to the target nucleic acid molecule.

Claim 152. (currently amended) A method for hybridizing an antisense molecule to a target nucleic acid molecule, comprising the steps of:

- (a) providing a coated article according to claim 1 or claim 72;
- (b) detaching one or more compounds from said coated article, wherein the attached compounds are antisense molecules; and
- (c) contacting the compound(s) with a composition comprising a target nucleic acid molecule, and thereby hybridizing an antisense molecule to the target nucleic acid molecule.

Reasons for Allowance

2. Applicant's amendment filed August 10, 2004, has been entered. Claims 1, 42, 72, 78, 150, 154, and 156 have been amended as requested. Claims 37, 82, 83, and 88 have been cancelled, while new claims 158 and 159 have been added.

Art Unit: 1771

3. Said amendment is sufficient to withdraw the prior art rejections set forth in sections 5-8 of the last Office Action. Specifically, the allowable subject matter of claim 88 has been incorporated into independent claim 72. Thus, claims 72-81, 84-87, and 89-91 are allowed. Additionally, the allowable subject matter of claims 82 and 83 have been incorporated into claims 154-159. Hence, said claims are also allowable.

4. In view of said allowable subject matter, the withdrawn species claims are rejoined, as well as the withdrawn method claims.

5. An updated search of the art produced US 6,159,681 issued to Zebala, which could be used in conjunction with the Hendrickson reference to reject at least claims 1-36, 38-41, 149, and 153. However, as noted in the attached Interview Summary, applicant's statement of co-assignment under 103(c) is sufficient to remove the Zebala reference. Thus, claims 1-36, 38-41, 149, and 153 are allowed.

6. The above examiner's amendment for claims 42 and 92 is made to bring the claims to the same scope of allowable subject matter (i.e., porous coating with two or more different compounds attached thereto). Thus, claims 42-71 and 92-128 are also allowed.

7. Additionally, the examiner's amendment to claims 129, 135, 148, 150, 151, and 152 is made to place the claims in condition for allowance. As such, claims 129-148 and 150-152 are allowed.

Conclusion

8. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

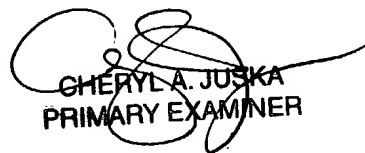
Art Unit: 1771

fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CHERYL A. JUSKA
PRIMARY EXAMINER

cj
September 18, 2004